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UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D. C. 20230  
www.uspto.gov

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 8, 13, 18, 19, 22, 29, 35, 38 and 44 of the morning section and questions 20, 23, 36, 38 and 39 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On July 26, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

**OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded one point for morning question 44. Accordingly, petitioner has been granted one additional point on the Examination. However, no credit has been awarded for morning questions 8, 13, 18, 19, 22, 29, 35 and 38 and afternoon questions 20, 23, 36, 38 and 39. Petitioner's arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

The model answer is choice (D).

Choice (D) is correct because MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION – TIME FOR REPLY" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate." (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

Petitioner argues that answer (C) is correct. Petitioner contends that May 30 terminated the 3 month period beginning March 27 because May 29 was a federal holiday and May 27 to 28 were weekend dates. Petitioner concludes that answer (D) is incorrect and maintains that answer (C) is correct.

Petitioner's argument has been fully considered but is not persuasive. As explained in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION - TIME FOR REPLY" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." The question states that applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000, less than two months from the mailing of the final rejection. May 31 is the date that the examiner responded with an advisory action, rendering the statement in answer (D) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 13 reads as follows:

13. The specification of a patent application contains limited disclosure of using antisense technology in regulating three particular genes in *E. coli* cells. The specification contains three examples, each applying antisense technology to regulating one of the three particular genes in *E. coli* cells. Despite the limited disclosure, the specification states that the "the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed such as bacteria, yeast, and other cellular organisms." All of the original claims in the application are broadly directed to the application of antisense technology

to any cell. No claim is directed to applying antisense technology to regulating any of the three particular genes in *E. coli* cells. The examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. The publication cites the inventor's own articles (published after the application was filed) that include examples of the inventor's own failures to control the expressions of other genes in *E. coli* and other types of cells. The rejection is:

(A) appropriate. The claims are not commensurate in scope with the breadth of enablement inasmuch as the working examples in the application are narrow compared to the wide breadth of the claims, the unpredictability of the technology, the high quantity of experimentation needed to practice the technology in cells other than *E. coli*.

(B) appropriate. The claims are not commensurate in scope with the breadth of the enablement inasmuch no information is provided proving the technology is safe when applied to animal consumption.

(C) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the specification discloses that the "the practices of this invention are generally applicable with respect to any organism containing genetic material capable of being expressed."

(D) inappropriate. The claims are commensurate in scope with the breadth of enablement inasmuch as the claims are original, and therefore are self-supporting.

(E) inappropriate. The claims are commensurate in scope with the breadth of the enablement inasmuch as the inventor is not required to theorize or explain why the failures reported in the article occurred.

The model answer is choice (A).

Choice (A) is the best answer. 35 U.S.C. § 112, first paragraph. *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999). As stated in MPEP § 2164.01, "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term 'undue experimentation,' it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." (B) is incorrect. As stated in MPEP 2107, part c. The requirement of 35 U.S.C. 101, for a "practical" utility or otherwise, is not a requirement that an applicant demonstrate that a utility is a safe or

fully effective for human or animal consumption. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). (C) is incorrect. The disclosure is inconsistent with published information. 35 U.S.C. § 112, first paragraph. (D) is incorrect. Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. The lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims.

Petitioner argues that (C) is correct. Petitioner contends that the publication should not negate patentability because the applicant's failures to control the expressions of other genes in *E. Coli* and other types of cells are examples only and not conclusory.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the publications of applicant citing failures are examples only and not conclusory and should not negate patentability, the question specifically states that the examiner rejects the claims under 35 U.S.C. § 112, first paragraph, for lack of enablement citing a publication that correctly notes antisense technology is highly unpredictable, requiring experimentation to ascertain whether the technology works in each type of cell. This has little to do with whether the examples work or fail, but the level of experimentation required to practice the claimed invention. The statement in answer (C) is incorrect. The disclosure is inconsistent with published information. 35 U.S.C. § 112, first paragraph. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is NOT a policy underlying the public use bar of 35 U.S.C. § 102(b)?
- (A) Discouraging the removal, from the public domain, of inventions that the public reasonably has come to believe are freely available.
  - (B) Favoring the prompt and widespread disclosure of inventions.

- (C) Allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent.
- (D) Increasing the economic value of a patent by extending the effective term of the patent up to one year.
- (E) Prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time.

The model answer is choice (D).

Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

Petitioner argues that (E) is correct. Petitioner contends that (E)'s reference to statutorily prescribed time refers to that in other countries, which 35 USC 102(b) grant of one year over such time makes (E) the proper answer as not a policy. Petitioner makes no argument that answer (D) is incorrect but maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that answer (E) refers to statutorily prescribed time refers to that in other countries and therefore is not a policy underlying the public use bar, the answer specifically states that prohibiting the inventor(s) from commercially exploiting the invention for a period greater than the statutorily prescribed time is not a policy underlying the public use bar. As explained in *Lough*, this is such a policy. Further, contrary to petitioner's assertion that statutory time refers to other countries, the instructions specifically state that the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*, not the statutes of other

countries. Accordingly, allowing the inventor(s) a reasonable amount of time following sales activity to determine the potential economic value of a patent is a policy underlying the public use bar, rendering (E) incorrect. The statement in answer (D) is correct and has not been argued by petitioner. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 19 reads as follows:

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim 1, the sole claim. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled "electronics control unit." Claim 1 of the Williams application is as follows:

**Claim 1. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit coupled to the infrared sensor and the timer mechanism.**

You received a final Office action, dated February 1, 2000, containing an indication that claim 1 is allowable subject matter, but objecting to the specification, on the grounds that the subject matter of the electronics control unit, though adequately described in the original specification, was required to be shown in the drawings. Which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection?

(A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.

(B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.

(C) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.

(D) On September 1, 2000, file a petition urging that no further drawing should be



required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.

(E) None of the above.

The model answer is choice (B).

Selection (B) is correct as per 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). Choices (A), (C), and (D) are incorrect. As stated in MPEP § 706.03(o), "If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing." See MPEP § 608.01(l). (D) is incorrect because the reply is not timely. (E) is incorrect because (B) is correct.

Petitioner argues that none of the answers is correct. Petitioner contends that the examiner should not accept drawings after final, but should wait for a continuation. Petitioner concludes that answer (B) is incorrect and maintains that answer (E) is correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the examiner should not accept drawings after final, but should wait for a continuation, the question specifically asks which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection. As explained in the instructions, the most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. MPEP § 706.03(o) states "If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing." Also see MPEP § 608.01(l). Accordingly, answer (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 22 reads as follows:

22. Which of the following rejections can properly be overcome using a 37 C.F.R. § 1.131 affidavit?

- I. A rejection under 35 U.S.C. § 102(a) based on a journal article that describes the invention as claimed.
- II. A rejection under 35 U.S.C. § 102(b) based on a patent that discloses but does not claim the invention.
- III. A rejection based on statutory double patenting.
- IV. A rejection under 35 U.S.C. § 102(e) based on a patent that discloses but does not claim the same patentable invention.

- (A) I.
- (B) II.
- (C) III.
- (D) IV.
- (E) I and IV

The model answer is choice (E).

(E) is correct. MPEP §§ 715 and 804.02. (II) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a rejection under 35 U.S.C. § 102(b). MPEP 715. (III) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a statutory double patenting rejection. MPEP § 804.02. Thus (B) and (C) are incorrect

Petitioner argues that (D) is correct, implying that I is incorrect. Petitioner contends that I is incorrect because an affidavit cannot overcome art predating the invention. Petitioner concludes that answer (E) is incorrect and maintains that answer (D) is correct.

Petitioner's argument has been fully considered but is not persuasive. A 37 C.F.R. § 1.131 affidavit may overcome the rejection if the applicant can establish that the invention was invented before the publication date of the article. See MPEP 715. Petitioner incorrectly assumes that the art predates the invention. As explained in the instructions, do not assume any

additional facts not presented in the questions. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 29 reads as follows:

29. You are attorney of record appointed by XYZ Corp. to prosecute a patent application directed to an invention assigned to the XYZ Corp. by an employee-inventor. In the course of prosecution, you receive an Office action rejecting all the claims as anticipated by a patent to Williams. After carefully reviewing the Office action and discussing the same with XYZ officers, it is concluded that the rejection is sound. In accordance with instructions from XYZ officers, you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention, and an express abandonment signed by you under 37 C.F.R. § 1.138. An appropriate PTO official acknowledges receipt and accepts the express abandonment. Shortly thereafter, you receive an urgent call from the employee-inventor, who informs you that she just learned of the action taken to abandon the application, and that she has reviewed the Williams patent and concluded that her invention differs therefrom in a subtle but significant manner. Which of the following courses of action, if any, are properly available to you to successfully revive the application in accordance with proper PTO practice and procedure?

(A) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was without the inventor's consent.

(B) Request reconsideration of the abandonment on the ground that the filing of the express abandonment was the result of a mistake.

(C) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(a) on the ground that the filing of the express abandonment was unavoidable.

(D) File a petition to revive the application with all the elements required under 37 C.F.R. § 1.137(b) on the ground that the filing of the express abandonment was unintentional.

(E) None of the above.

The model answer is choice (E).

(E) is correct because the express abandonment was the result of a deliberative, intentional course of action. MPEP 711.01. Thus, (A), (B), (C), and (D) are wrong. (A) is wrong because an express abandonment is effective if signed by the attorney or agent of record. 37 C.F.R. § 1.138.

(B) is wrong because the express abandonment was filed, not as a mistake, but as the result of a deliberative, intentional course of action, i.e., after careful review of the Office action and the Williams patent, and discussions with XYZ officials. The arrival by you at a different conclusion after reviewing the same facts a second time is not a mistake of fact. *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). (C) and (D) are wrong because MPEP § 711.03(c) recites, "An intentional abandonment of an application...precludes a finding of unavoidable or unintentional delay pursuant to 37 C.F.R. § 1.137. See *Maldague*, 10 USPQ2d at 1478."

Petitioner argues that (C) is correct. Petitioner contends that the question fails to state that the assignment was recorded, negating XYZ's right to abandon the application.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the question fails to state that the assignment was recorded, negating XYZ's right to abandon the application, the question specifically states that you file in the PTO a certification by XYZ Corp. that it is the assignee of the invention. Accordingly, XYZ does have the right to abandon the application, rendering (C) incorrect. There is nothing in the fact pattern implying that the assignment was flawed. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 35 reads as follows:

35. On July 1, 1998, a registered practitioner files an application containing 10 claims that are directed to a computer. The practitioner thereafter receives an Office action wherein claims 1 - 5 are properly rejected under 35 U.S.C. § 102 based upon reference A dated January 3, 1999. Reference A is an abstract identifying a computer, the computer's vendor, and information informing potential buyers whom to contact, price terms, documentation, warranties, training and maintenance programs, and the date of the computer's release to the public. In sufficient detail to meet the requirements of 35 U.S.C. § 112, reference A describes a computer having all of the elements of the rejected claims. According to reference A, the computer described therein was publicly sold in the United States in June 1997. As a practitioner, what should you advise your client to do in accordance with proper PTO practice and procedure?

(A) File a reply arguing that Reference A cannot constitute prior art since it is dated subsequent to the filing date of the application.

(B) File an amendment canceling the rejected claims and argue patentability of the remaining claims.

(C) Argue that reference A constitutes hearsay evidence because there is no direct evidence that the computer of Reference A was actually in existence in June 1997.

(D) Argue that even if the computer of Reference A was in existence in June 1997, the failure to disclose the invention until 1999 constituted abandonment of the invention.

(E) Request a public use hearing to determine if there actually was public use in June 1997

The model answer is choice (B).

(B) is the best answer. As to (A), (D) and (E), see MPEP §§ 716.07 and 2133.03 (b), page 2100-74 and *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994).

Petitioner argues that (C) is correct. Petitioner contends that the abstract is hearsay, lacking evidence that the disclosed computer actually existed.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the abstract is hearsay, lacking evidence that the disclosed computer actually existed, the question specifically states that in sufficient detail to meet the requirements of 35 U.S.C. § 112, reference A describes a computer having all of the elements of the rejected claims and stated that the computer described therein was publicly sold in the United States in June 1997. As explained in MPEP 2133.03(b), abstracts identifying a product's vendor containing information useful to potential buyers such as whom to contact, price terms, documentation, warranties, training and maintenance along with the date of product release or installation before the inventor's critical date may provide sufficient evidence of prior sale by a third party to support a rejection based on 35 U.S.C. 102(b) or 103. *In re Epstein*, 32 F.3d 1559.

31 USPQ2d 1817 (Fed. Cir. 1994). Accordingly, such an abstract is permissible evidence, rendering the statement in answer (C) incorrect and answer (B) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 38 reads as follows:

38. Inventor Charles patented a whirlwind device for defeathering poultry. Although the scope of the claims never changed substantively during original prosecution of the patent application, practitioner Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. After the patent issued, Charles realized that the claims were unduly narrow, and that the limitations argued by Roberts were not necessary to patentability of the invention. Accordingly, a timely application was made for a broadened reissue patent in which Charles sought claims without limitations relied upon by Roberts during original prosecution.

The new claims were properly supported by the original patent specification. Charles asserted in his reissue oath that there was an error in the original patent resulting from Roberts' failure to appreciate the full scope of the invention during original prosecution of the application. No supporting declaration from Roberts was submitted in the reissue application. Based on the foregoing facts and controlling law, which of the following statements is most accurate?

- (A) Although the scope of the claims was not changed substantively during prosecution of the original patent, the recapture doctrine may preclude Charles from obtaining the requested reissue because of the repeated arguments made by practitioner Roberts.
- (B) The recapture doctrine cannot apply because the claims were not amended substantively during original prosecution.
- (C) The reissue application will not be given a filing date because no supporting declaration from practitioner Roberts was submitted.
- (D) The doctrine of prosecution history estoppel prevents Charles from seeking by reissue an effective claim scope that is broader than the literal scope of the original claims.
- (E) The doctrine of late claiming prevents Charles from seeking an effective claim scope broader than the literal scope of the original claims.

The model answer is choice (A).

Selection (A) is the best answer as per *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because "late claiming" was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

Petitioner argues that (B) is correct. Petitioner contends that the arguments made during prosecution were not necessary to patentability and therefore cannot form a basis for recapture.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the arguments made during prosecution were not necessary to patentability and therefore cannot form a basis for recapture, the question specifically stated that Roberts repeatedly argued that limitations appearing in the original claims distinguished the claimed subject matter from prior art relied upon by the examiner in rejecting the claims. The statement in answer (B) is incorrect and (A) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 20 reads as follows:

20. Which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000?

I. The examiner set a shortened statutory period of three months for replying to the Office action, and three months from September 25, 2000 falls on Christmas Day, December 25, 2000, a federal holiday, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.

II. The examiner's interpretation of the prior art in rejecting certain claims, as set

forth in the Office action, is believed by a registered practitioner to be contrary to the interpretation given by one of ordinary skill in the art, and the practitioner calls this alone to the examiner's attention within one month of the mail date of the office action.

III. The examiner incorrectly cited one of the references, and the registered practitioner calls this to the attention of the examiner within one month of the mail date of the Office action.

- (A) I.
- (B) II.
- (C) III.
- (D) II and III.
- (E) None of the above.

The model answer is choice (C).

(C) is the most correct answer. MPEP § 710.06. (I) is incorrect since this does not constitute error by the examiner. (II) is incorrect, since a reply would be due by the reply date, regardless of whether the rejection was traversed. Thus (A), (B), and (D) are incorrect. (E) is incorrect because C is correct.

Petitioner argues that (E) is correct. Petitioner contends that the practitioner did not request that the period be restarted.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the practitioner did not request that the period be restarted, the question specifically asks which of the following is (are) appropriate for restarting the period for replying to an Office action, dated September 25, 2000. The question does not ask which would necessarily result in resetting. Accordingly, (C) is a circumstance warranting resetting of the time period under MPEP 710.06, rendering (C) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 23 reads as follows:



23. In 1998, Chris invents an automobile or truck windshield wiper device that uses a transparent grid to automatically sense water drops on the windshield and wipe the window whenever a drop appears. The grid detects current variations when moisture impregnates the grid, and then activates the windshield wiper. In April 1998, Chris submitted an article for publication in Popular Scientist magazine disclosing the invention. The magazine edited the article to the extent that the article, published August 1, 1998, fails to enable one of ordinary skill in the art to make the invention. On August 31, 1998, Chris offers the automobile windshield wiper device for sale to the Ajax Motor Company, leaving a sample device for use in automobiles at the Ajax plant. Chris knew his device can be used with trucks only if the sensors are modified to accommodate the larger windshields, however no such modification has been made. Without Chris' knowledge, Ajax intends to use the device on its trucks. Ajax modifies and successfully tests the device using larger sensors for trucks on a public highway on September 1, 1998. Chris files a patent application with the PTO for the basic concept for automotive windshields on August 2, 1999. On August 30, 1999, Chris realizes that Ajax modified his invention to work with trucks on September 1, 1998, and that his claims do not cover the truck embodiment. There is no basis in the application supporting a claim directed to the embodiment for trucks, but the modification would have been obvious to one of ordinary skill in the art. Chris' application has not yet issued. He comes to you, a registered practitioner, for advice on the morning of August 30, 1999 as to whether he should file a new application for his windshield wiper directed to trucks and buses. What should you advise Chris to do in accordance with proper PTO practice and procedure?

- (A) The Popular Scientist publication is a bar under 35 U.S.C. § 102(b) since it was filed over a year before the application was filed.
- (B) Chris can still file a claim in the pending application directed to windshield wipers for trucks because the modification of the sensors would have been obvious to the artisan.
- (C) Chris must file a new application on or before September 1, 1999, to avoid the testing by Ajax from becoming a statutory bar to him obtaining a second patent directed to the windshield wiper for trucks embodiment.
- (D) Chris may file a continuation-in-part application anytime before the first patent application issues in which he can disclose and claim the windshield wiper device for use on trucks and buses since a continuation-in-part is entitled to the parent filing date for everything disclosed in the continuation-in-part application.
- (E) Since the Ajax use of the device on trucks was not discovered until August 31, 1999, Chris has one year from August 31, 1999, to file a new patent application directed to use of his invention on trucks.

The model answer is choice (C).

As to answer (A), the publication in Popular Scientist was not enabling. Unless it is a statutory

bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself on his/her behalf. MPEP § 715.01(c). The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other. *Cf.* MPEP § 2121. "In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'..." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). MPEP § 2121.01. As to answer (B), 35 U.S.C. 132 states that "[n]o amendment shall introduce new matter into the disclosure of the invention." As to (C), statutory bars of 35 USC 102(b) are applicable even though public use is by a third party. MPEP § 2133.03(e)(7). The statutory bar would apply to the modification by Ajax to use the windshield wiper device on trucks. As to (E), it is not necessary that the applicant be aware of the public use by the third party Ajax. As to (D), Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment.

Petitioner argues that (D) is correct. Petitioner contends that a continuation-in-part application can be filed.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that a continuation-in-part can be filed, the answer (D) is not true because a continuation-in-part is not entitled to the filing date of the parent application for subject matter that is not supported by the disclosure of the parent application. Chris would be barred by the public use of the truck embodiment by Ajax on September 1, 1998 as the C-I-P would not receive the benefit of the earlier filing date with respect to the truck embodiment since the original disclosure did not include the truck embodiment. Accordingly, (D) is incorrect. Obviousness-type double patenting will not prevent Chris from obtaining a second patent, rendering the statement in answer (C) correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is true?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

As to (B), see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that (A) is correct. Petitioner contends that in (A), the practitioner notified the Director of OED of his address changes before filing the change of addresses in the applications.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that the practitioner notified the Director of OED of his address changes

before filing change of addresses in the applications, the answer (A) specifically states that it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible. As explained in 37 C.F.R. § 10.11 (a), this is false. Accordingly, petitioner's assumption that the practitioner did file the change of address notification with the Director is unfounded, rendering the statement in answer (A) incorrect. Statement (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 38 reads as follows:

38. Which of the following statements correctly describes current PTO practice and procedure?

(A) A joint application by inventors Sam and Will, and a joint application by Will and Sam are different inventive entities.

(B) A joint application by inventors Sam and Will, and a sole application by Sam are different inventive entities.

(C) Where a patent is granted to Will, and later Will and Sam file a joint application, the presence of Will, a common inventor in the patent, prevents a determination that the patent entity is to "another" within the meaning of 35 U.S.C. § 102(e).

(D) The fact that an application has named a different inventive entity (Sam and Will) than a patent reference (Will) makes the patent prior art, even where one of the inventors is common to both.

(E) (A) and (C).

The model answer is choice (B).

(B) is the most correct answer. *Ex parte Utschig*, 156 USPQ 156, 157 (Bd. App. 1966); MPEP § 2137.01 (section styled "Inventorship Is Generally 'To Another' Where There Are Different Inventive Entities With At Least One Inventor In Common"). (A) is incorrect. The same inventive entity obtains, regardless of the order in which the inventors are

listed, inasmuch as the same inventors are recited. (C) is incorrect. The presence of a common inventor in a reference patent and application does not preclude determination that the inventive entity in the reference is to another within the meaning of 35 U.S.C. § 102(e). *Ex parte DesOrmeaus*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). (D) is incorrect. Merely the fact that the inventive entities differ does not cause the patent to necessarily be prior art. *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281, 15 USPQ2d 1816, 1818 (Fed. Cir. 1988); MPEP § 2137.01. (E) is incorrect because (A) and (C) are incorrect.

Petitioner argues that (D) is correct. Petitioner contends that a patent with a different inventive entity can be prior art.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that a patent with a different inventive entity can be prior art, the answer (D) specifically states that the fact that an application has named a different inventive entity (Sam and Will) than a patent reference (Will) makes the patent prior art, even where one of the inventors is common to both. Petitioner is arguing an answer different from the answers present for the question. Answer (D) said the different entity makes, not could make, the patent become prior art. "The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281, 15 USPQ2d 1816, 1818 (Fed. Cir. 1988). MPEP § 2137.01 states "the claimed invention in a later filed application is entitled to the benefit of an earlier filed application under 35 U.S.C. 120 (an overlap of inventors rather than an identical inventive entity is permissible). Accordingly the statement in answer (D) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 39 reads as follows:

39. A U.S. patent issued to Smith on January 6, 1998. Realizing that the claims of the issued

patent were too narrow, Smith properly filed a broadening reissue application on September 30, 1999. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith recognized that additional claims should be added to provide the desired range of patent protection. On March 17, 2000, Smith submitted an Amendment that, *inter alia*, added new claims 20-33 to the reissue application. Each of claims 20-22 was broader than the claims originally submitted on September 30, 1999, with the application for a broadened reissue. Each of claims 23-28 was narrower than the claims originally submitted on September 30, 1999, but broader than the original patent claims. Each of claims 29-33 was narrower than the original patent claims. The reissue oath originally filed with the reissue application is adequate to support the newly submitted claims. Which of the following best describes a proper action by the examiner in reply to the Amendment?

(A) Each of claims 20-33 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.

(B) Each of claims 20-33 is examined on the merits, but are not rejected for improperly broadening the reissue application after the two-year anniversary of the original patent issue.

(C) Claims 20-28 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 29-33 are examined on the merits.

(D) Claims 20-22 are rejected as being improper because they were added after the two-year anniversary of the original patent issue, but claims 23-33 are examined on the merits.

(E) Claims 20-28 are examined on the merits, but claims 29-33 are rejected as improper because this is a broadening reissue application and these claims are narrower than the original patent claims.

The model answer is choice (B).

Choice (B) is the best answer. When, as here, a broadening reissue is applied for within the two-year time limit set forth in 35 U.S.C. § 251, an amendment presenting further broadened claims after the two-year period is appropriate if the later-presented claims are supported by the original reissue oath. *In re Doll*, 419 F.2d 925, 928, 164 USPQ 218 (CCPA 1970); MPEP § 1412.03. Thus, answers (A), (C) and (D) are not correct. Answer (E) is not correct because a broadening reissue application does not preclude presentation of narrower claims. 37 C.F.R. § 1.175(a)(1) "more or less than patentee had a right to claim"; MPEP § 1444.

Petitioner argues that (D) is correct. Petitioner contends that claims were broadened after

two years the patent issued.

Petitioner's argument has been fully considered but is not persuasive. The question specifically states that Smith properly filed a broadening reissue application on September 30, 1999, which is within 2 years of the date of issue, January 6, 1998. When, as here, a broadening reissue is applied for within the two-year time limit set forth in 35 U.S.C. § 251, an amendment presenting further broadened claims after the two-year period is appropriate if the later-presented claims are supported by the original reissue oath. *In re Doll*, 419 F.2d 925, 928, 164 USPQ 218 (CCPA 1970); MPEP § 1412.03. Accordingly, the statement in answer (D) is incorrect and (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

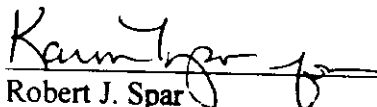
The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000) (The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

  
Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy